

REMARKS

This Amendment is responsive to the Office Action dated March 29, 2004. Claims 1-58 were pending in the application. In the Office Action, claims 1-58 were rejected. In this Amendment, claims 1, 6, 7, 11-13, 15, 22, 30, 35, 36, 40-42, 44 and 51 have been amended. Claims 1-58 thus remain for consideration

Applicants submit that claims 1-58 are now in condition for allowance and request reconsideration and withdrawal of the rejections in light of the following remarks.

§112 Rejections

Claims 6, 7, 11-13, 15, 35, 36, 40-42 and 44 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants have amended claims 6, 7, 11-13, 15, 35, 36, 40-42 and 44 and submit that claims 6, 7, 11-13, 15, 35, 36, 40-42 and 44 are now in compliance with §112. Accordingly, Applicants request that the rejections under §112 be withdrawn.

Regarding the use of the term “substantially,” the Court of Appeals for the Federal Circuit has held that using the term “substantially” in a patent claim does not of itself render the claim indefinite. That is, apart from other considerations, the use of the term “substantially” is not a violation of §112, second paragraph. In *Verve LLC v. Crane Cams Inc.*, 311 F.3d 1116; 65 U.S.P.Q.2d 1051 (Fed. Cir. 2002), the Federal Circuit vacated a district court finding that the claim language “substantially constant wall thickness” in the claims was not supported in the specification and prosecution history by a sufficiently clear definition of “substantially.” In reaching its decision the Court explained that

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. S 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988) the court explained that usages such as "substantially equal" and "closely approximate" may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that "like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995).

It is well established that when the term "substantially" serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite. Understanding of this scope may be derived from extrinsic evidence without rendering the claim invalid. The summary judgment record offered no basis for departing from these general rules. Thus the usage "substantially constant wall thickness" does not of itself render the claims of the '315 patent indefinite.

Verve, 65 U.S.P.Q.2d at 1054.

In the present case, use of the phrase "substantially" is necessary in order to provide the inventors with the benefit of their invention. It describes the invention with precision appropriate to the technology and without intruding on the prior art. In particular, Applicants use the term "substantially" to qualify certain measured values as being the stated value +/- a tolerance, a practice that is customary and well understood in the electrical arts. For example, in claim 6 a logical "1" is said to be represented by a level of "substantially 50-IRE"

It is well known that electrical signals are rarely maintained at a precise predetermined level for a precise predetermined period of time. Indeed, in the great majority of

cases, the actual value of an electrical signal at any given moment is not equal to the target value, but rather, falls within a range centered on the target value. The range for a particular signal value or signal period is often referred to as the “tolerance” and is analogous to the mechanical tolerances assigned to physical dimensions such as the diameter of a drilled hole. Thus, by using the term substantially to qualify signal values, Applicants have recited the signal values in a manner that is clearly understandable to those skilled in the field of the invention.

Regarding the 112 rejections of claims 22 and 51, Applicants note that the specification has been amended to correct for a typographical error concerning the description of the “trigger bits,” and that the “trigger bits” recitations of claims 22 and 51 are definite in view of the correction.

Double Patenting

Claims 1-7, 11-18, 22-26, 30-36, 40-47 and 51-55 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 09/611,145.

As noted by the Examiner, a timely filed terminal disclaimer may be used to overcome the provisional double patenting rejections provided the conflicting application is shown to be commonly owned with the present application.

It is not clear if the present application or Application No. 09/611,145 will issue first. Hence, Applicants will consider filing a Terminal Disclaimer if Application No. 09/611,145 issues first and if the claims of the present application are obvious in view of the claims of Application No. 09/611,145.

§102 and 103 Rejections

Claims 1, 2, 5, 30, 31 and 34 were rejected under 35 U.S.C. §102(b) as being anticipated by Kanota et al. (U.S. Patent No. 5,418,853).

Claims 3 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota in view of Okamoto et al. (U.S. Patent No. 5,627,655).

Claims 4 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota.

Claims 6, 7, 35 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota as applied to claim 1, and further in view of Dieterich (U.S. Patent No. 4,308,577).

Claims 8 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota as applied to claim 1, and further in view of Horton et al. (U.S. Patent No. 4,945,563).

Claims 9 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota as applied to claim 1, further in view of Kamitake (U.S. Patent No. 4,751,732), and further in view of Saito (U.S. Patent No. 5,504,933).

Claims 10 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota in view of Kamitake, and further in view of Saito as applied to claim 9, and further in view of Yamauchi (U.S. Patent No. 5,668,873).

Claims 11-15, 22, 24-26, 40-44, 51 and 53-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota, further in view of Ryan (U.S. Patent No. 4,631,603), and further in view of Ryan (U.S. Patent No. 4,695,901).

Claims 16-18, 23, 45-47 and 52 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota, further in view of Ryan ‘603, and further in view of Ryan ‘901 as applied to claim 11, and further in view of Ryan (U.S. Patent No. 4,577,216).

Claims 19, 27, 48 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota, further in view of Ryan ‘603, and further in view of Ryan ‘901 as applied to claims 11, 22, 40 and 51, and further in view of Horton.

Claims 20, 28, 49 and 57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota, further in view of Ryan ‘603, and further in view of Ryan ‘901 as applied to claims 11, 22, 40 and 51, and further in view of Kamitake, and further in view of Saito.

Claims 21, 29, 50 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kanota, further in view of Ryan ‘603, further in view of Ryan ‘901 as applied to claims 20, 28, 49 and 57, and further in view of Yamauchi.²

Applicants respectfully submit that the independent claims (claims 1, 11, 22, 30, 40 and 51) are patentable over Kanota, Okamoto, Dieterich, Horton, Kamitake, Saito, Yamauchi, Ryan ‘603, Ryan ‘901 and Ryan ‘216.

Applicants’ invention as recited in the independent claims is directed toward a method and apparatus for reproducing a video signal. Each of the claims recites “receiving a video signal with appended copy management information at a reproducing device via a satellite communication link.” Supporting disclosure for the satellite aspects of Applicants’ invention can be found in the specification at, for example, page 59, line 1 – page 64, line 9.

None of the cited references discloses receiving via satellite a video signal with appended copy management information. Accordingly, Applicants believe that claims 1, 11, 22, 30, 40 and 51 are patentable over the cited references – taken either alone or in combination – on at least this basis.

Claims 2-10 depend on claim 1. Since claim 1 is believed to be patentable over the cited references, claims 2-10 are believed to be patentable over the cited references based at least on their dependency on claim 1.

Claims 12-21 depend on claim 11. Since claim 11 is believed to be patentable over the cited references, claims 12-21 are believed to be patentable over the cited references based at least on their dependency on claim 11.

Claims 23-29 depend on claim 22. Since claim 22 is believed to be patentable over the cited references, claims 23-29 are believed to be patentable over the cited references based at least on their dependency on claim 22.

Claims 31-39 depend on claim 30. Since claim 30 is believed to be patentable over the cited references, claims 31-39 are believed to be patentable over the cited references based at least on their dependency on claim 30.

Claims 41-50 depend on claim 40. Since claim 40 is believed to be patentable over the cited references, claims 41-50 are believed to be patentable over the cited references based at least on their dependency on claim 40.

Claims 52-58 depend on claim 51. Since claim 51 is believed to be patentable over the cited references, claims 52-58 are believed to be patentable over the cited references based at least on their dependency on claim 51.

Applicants respectfully submit that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

If any issues remain, or if the Examiner has any further suggestions, he/she is invited to call the undersigned at the telephone number provided below.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

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